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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/086,116

02/26/2002

Roy Neff

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BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP

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EXAMINER

AKINTOLA, OLABODE

ART UNIT

PAPER NUMBER

3691

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/086,116	<b>Applicant(s)</b> NEFF ET AL.	
	<b>Examiner</b> OLABODE AKINTOLA	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 136-141 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 136-141 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/05/2008 has been entered.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is

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met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

As per Claim 13, Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26, 136 and 138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer et al (USPN 6418419) in view of Ojha et al (USPN 6598026).

Re claims 1, 7, 13 and 14: Nieboer discloses a method operable on a computer for responding to order flow, the method comprising: receiving from a trader an order; matching on the computer the order to the at least one condition comprising a rule (col. 2, lines 12-18; col. 3, lines 60-67);

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and automatically responding to the order in accordance with the at least one condition of the rule, if the at least one condition is satisfied, including generating a contra barter order that includes the contra order (col. 2, lines 12-18; col. 19, lines 1-20; see abstract).

Nieboer does not explicitly teach generating for a market maker a rule for automatically responding to an order, the rule, with no symbols specified, including at least one condition for automatically generating a contra order, the at least one condition allowing matching based on at least one characteristic; and providing the contra order for acceptance.

Ojha discloses the concept of generating for a seller (*market maker*) a rule for automatically responding to a bid (*order*), the rule, with no products (*symbols*) specified (see figs. 13D; “Buyer specific), including at least one condition for automatically generating a automatic response or contra offer such a discount (*contra order*), the at least one condition allowing matching based on buyer reputation (*at least one characteristic*); and providing the contra order for acceptance (see col. 7, lines 46-58, col. 15, lines 30 through col. 17, line 15; Figs. 13A-13K).

Nieboer however discloses that orders are sent and received from the Nasdaq market makers.

Nieboer further discloses means for matching orders including if the condition are met, that two or more securities are tradable. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nieboer to include these features as taught by Ojha in order to automatically generate appropriate contra order according the rules defined by the market participant with or without the name or symbol of the security.

Re claims 2, 8 and 16: Nieboer discloses the order further includes an effective time range (col. 2, lines 1-5; col. 15, lines 50-65; col. 8, lines 29-54; col. 17, lines 25-67).

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Re claims 3, 9, 18 and 23: Nieboer discloses wherein: the order includes first and second securities; and the at least one condition includes at least one variable selected from the group of variables including: identity of one of the first and second securities, delta between buy and sell prices of the first and second securities, relationship of SIC codes of at least one of the first and second securities and any other securities, market cap of at least one of the first and second securities, average daily trading volume of at least one of the first and second securities and debit value of the bid/ask spread of the first and second securities (col. 1, lines 42-65; col. 9, line 1 – col. 10, line 12).

Re claims 4 and 10: Nieboer discloses wherein each of the conditions further includes a mathematical operator and a value (col. 15, lines 1-10).

Re claims 5 and 11: Nieboer discloses wherein the rule further includes at least one pricing tier comprising an offer price range within which the rule is operative and an offer size value up to which the rule is operative (col. 8, lines 27-54); and if the rule is operative and if the at least one condition of the rule is satisfied, providing the contra order for the acceptance includes: if the order is a limit order, performing one of trading the order with at least one of a second order and contra order, (see fig. 8; col. 10, line 11-65), and posting the order request for consideration for execution; if the order is a market order, trading the order with at least one of the second order and the contra order; and if the contra order is accepted, trading the order (see fig. 8; col. 10, lines 11-65).

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Re claims 6 and 12: Nieboer discloses wherein the step of automatically responding includes prompting the operator to provide a manual response (col. 13, lines 1-40).

Re claims 15, 20, 25 and 26: see claims 1, 7, 13 and 14 analyses above.

Re claims 17 and 22: Nieboer discloses wherein receiving includes selecting at least one variable from the plurality of variables and operators, at least one operator from the plurality of variables and operators, and at least one constraint to form the at least one condition (see col. 17, table 1; col. 15, lines 1-45).

Re claims 19 and 24: Nieboer discloses wherein the rule further includes at least one pricing tier comprising an offer price range within which a rule is operative and an offer size value up to which a rule is operative (col. 11, lines 40-60).

Re claim 21: Nieboer discloses wherein: the order further includes a time and date range (col. 2, lines 1-5; col. 15, lines 50-65; col. 8, lines 29-54; col. 17, lines 25-67).

Re claims 136 and 138: Nieboer further discloses the method wherein the contra order includes a first security and a second security (col. 8, lines 29-54; col. 17, lines 25-67; col. 19, lines 1-20)

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Claims 137 and 139-141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer in view of Ojha as applied to claims 1 or 13, and 7 or 14 above, and further in view of Santoli ("The Striking Price: Some Option", Barron's. New York, N.Y.: Aug 23, 1999. Vol. 79, Iss. 34' pg. MW13, Ipgs).

Re claims 137, 139, 140 and 141: Nieboer fails to explicitly disclose the method wherein the contra order is an implied order.

Santoli discloses the market makers posting phantom bids and offers (*implied orders*) (page 1 of 3, paragraph 6). Accordingly, it would have been obvious to one of ordinary skill in the art at time of the invention to modify the Nieboer and Ojha combination to include implied orders as taught by Santoli in order to respond to users' exact orders by generating implied order.

### ***Response to Arguments***

Applicant's arguments filed 11/05/2008 have been fully considered but they are not persuasive.

Applicant argues that Nierbor and Ojha fails to teach or suggest, separately or in combination, the claimed methods and systems which match orders based on characteristics with no symbols specified. Examiner respectfully disagrees. Ojha teaches this concept. Particularly, Ojha discloses that the seller can define any number of business rules include product specific or buyer specific rules (see Figs. 13D and 13C). With the buyer specific rule, seller need not specify the product name or UPC code (equivalent to symbols) for generating automatic responses.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/  
Examiner, Art Unit 3691